



UNITED STATES PATENT AND TRADEMARK OFFICE

MD
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,402	01/15/2002	William C. King		5298
7590	10/03/2003		EXAMINER	
JAMES D. WELCH 10328 PINEHURST AVE. OMAHA, NE 68124			DEXTER, CLARK F	
			ART UNIT	PAPER NUMBER
			3724	
			DATE MAILED: 10/03/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/047,402	Applicant(s)	
	King	
Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Jul 24, 2003

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above, claim(s) 2-7, 9, 10, and 21-26 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 8, 11-20, and 27 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>2</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3724

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group II in the response filed July 24, 2003 (paper no. 4) is acknowledged. The traversal is on the ground(s) that "the common Patentable aspect in all Claims is the presence of the Longitudinal Slit." This is not found persuasive because although applicant's position is that it is the longitudinal slit that makes the invention patentable, it is the combination of the longitudinal slit along with elements claimed therewith that requires consideration. It is noted, however, that upon the determination that a claim is allowable, rejoinder of claims dependent therefrom will be considered.

Further, during a telephone conversation with Mr. James Welch on September 30, 2003, applicant elected the species II A, shown in Figures 3-5b. This species is readable on claims 1, 8, 11-20 and 27.

2. Claims 2-7, 9, 10 and 21-26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 3724

Information Disclosure Statement

3. The information disclosure statement filed January 15, 2002 (paper no. 2) has been received and the references listed thereon have been considered.

Drawings

4. The drawings are objected to because of the following informalities:

In Figure 1a, features CS, CG and ES should be changed (e.g., CSO, CGO and ESO) because they are different from those corresponding features in the other embodiments of the invention.

In Figures 5c and 5d, the use of CG is improper since it is a modified version of that shown in the previous embodiment, and it seems that it should be changed to --CG'-- or the like.

In Figures 5e and 5f, the use of CG is improper since it is a modified version of that shown in the previous embodiment, and it seems that it should be changed to --CG"-- or the like.

A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the motor as set forth in claims 1,
11, 19 and 27, and the half-a-dumbbell-shaped elements set forth in claims 17 and 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Art Unit: 3724

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Abstract

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because the recitation "Disclosed is a" is improper, and it seems that it should be changed to --A-- or the like. Appropriate correction is required. See MPEP § 608.01(b). 

Art Unit: 3724

Claim Rejections - 35 USC § 112

8. Claims 1, 8, 11-20 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of such language.

In claim 1, lines 1-2, the recitation "a cutter providing chain saw chain" is vague and indefinite as to what is being set forth; in line 5, "functionally interconnected" is vague and indefinite as to what is being set forth; in lines 8-9, the recitation "into which said chain link mating elements slideably insert" is vague and indefinite as to what is being set forth, and it is suggested to change "slideably insert" to --are slideably inserted-- or the like; in lines 13-14, the recitation "as said chain saw is viewed in side elevation" is vague and indefinite as to what is being set forth; in line 16, the recitation "at at least" is awkward and vague, and it is suggested to changed it to --at least at-- or the like; in lines 18-19, the recitation "thereby the causing of a "stretching" of the chain saw chain" is vague and indefinite as to what is being set forth, and further the recitation of "stretching" in quotations renders the term indefinite as to what is being implied by the quotations.

In claim 8, lines 3-4, the recitation "as said chain saw is viewed in side elevation" is vague and indefinite as to what is being set forth; in line 5, "the upper and lower portions" lacks

Art Unit: 3724

positive antecedent basis; in line 6, the recitation "at at least" is awkward and vague, and it is suggested to change it to --at least at-- or the like.

In claim 11, lines 1-2, the recitation "a cutter providing chain saw chain" is vague and indefinite as to what is being set forth; in line 5, "functionally interconnected" is vague and indefinite as to what is being set forth; in lines 8-9, the recitation "into which said chain link mating elements slideably insert" is vague and indefinite as to what is being set forth, and it is suggested to change "slideably insert" to --are slideably inserted-- or the like; in lines 15-16, the recitation "and/or from the top to bottom thereof said offset, when present" is vague and indefinite as to what is being set forth; in line 17, the recitation "chain link mating elements" is vague as to whether it refers to the elements previously set forth or to other such elements; in lines 20-21, the recitation "as said chain saw is viewed in side elevation" is vague and indefinite as to what is being set forth; in line 21, "the upper and lower portions" lacks positive antecedent basis; in line 24, the recitation "at at least" is awkward and vague, and it is suggested to change it to --at least at-- or the like; in lines 25-26, the recitation "thereby the causing of a "stretching" of the chain saw chain" is vague and indefinite as to what is being set forth, and further the recitation of "stretching" in quotations renders the term indefinite as to what is being implied by the quotations.

In claim 12, line 2, the recitation "is caused to be in an offset position" is vague and indefinite as to what is being set forth, particularly as to what causes the offset; in line 4, "an a" is vague; in lines 4-5, the recitation "a continuous chain channel guide alignment means" is

Art Unit: 3724

vague as to what is being set forth, particularly since there is no function set forth for the “means” recitation; in line 6, the recitation “chain link mating elements” is vague as to whether it refers to the elements previously set forth or to other such elements.

In claim 13, lines 4-5, “the continuous chain channel guide means” lacks antecedent basis.

In claim 14, line 2 is awkwardly worded and vague, and it seems that a word such as --in-- should be inserted after “slit”.

In claim 15, line 2, the recitation “is caused to be in an offset position” is vague and indefinite as to what is being set forth, particularly as to what causes the offset; in line 6, the recitation “chain link mating elements” is vague as to whether it refers to the elements previously set forth or to other such elements.

In claim 16, line 2, “second” renders the claim vague and indefinite, particularly since there is no “first”; in lines 4-5, “the continuous chain channel guide means” lacks antecedent basis.

In claim 17, line 2 is awkwardly worded and vague, and it seems that --a-- should be inserted before “half”; in lines 4-5, “the continuous chain channel guide means” lacks antecedent basis.

In claim 18, line 2, “second” renders the claim vague and indefinite, particularly since there is no “first”; in line 5, “the continuous chain channel guide means” lacks antecedent basis.

Art Unit: 3724

In claim 19, lines 1-2, the recitation "a cutter providing chain saw chain" is vague and indefinite as to what is being set forth; in line 5, "functionally interconnected" is vague and indefinite as to what is being set forth; in lines 8-9, the recitation "into which said chain link mating elements slideably insert" is vague and indefinite as to what is being set forth, and it is suggested to change "slideably insert" to --are slideably inserted-- or the like; in lines 13-14, the recitation "means ... which allows effecting" is vague and indefinite as to what is being set forth, and it is suggested in both lines 13 and 14 to change "which allows" to --for-- or the like; in lines 19-20, the recitation "as said chain saw is viewed viewed in side elevation" is vague and indefinite as to what is being set forth; in line 20, "the upper and lower portions" lacks positive antecedent basis; in line 23, the recitation "at at least" is awkward and vague, and it is suggested to changed it to --at least at-- or the like; in lines 24-25, the recitation "thereby the causing of a "stretching" of the chain saw chain" is vague and indefinite as to what is being set forth, and further the recitation of "stretching" in quotations renders the term indefinite as to what is being implied by the quotations.

In claim 20, lines 1-2, the recitation "means ... which allows effecting" is vague and indefinite as to what is being set forth.

In claim 27, lines 1-2, the recitation "a cutter providing chain saw chain" is vague and indefinite as to what is being set forth; in line 5, "functionally interconnected" is vague and indefinite as to what is being set forth; in lines 8-9, the recitation "into which said chain link mating elements slideably insert" is vague and indefinite as to what is being set forth, and it is

Art Unit: 3724

suggested to change "slideably insert" to --are slideably inserted-- or the like; in lines 15-18, the recitation "as said chain saw is viewed in side elevation, the top of said lateral slit to the bottom thereof and/or, as viewed from the top, from one side of the lateral slit to the other side thereof" is vague and indefinite as to what is being set forth.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3724

10. Claim 27✓ is provisionally rejected under the judicially created doctrine of double patenting over the claims of copending Application No. 09/853,942. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

Prior Art

11. Further consideration of the claimed invention with respect to the prior art will be given upon clarification of the claimed invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Art Unit: 3724

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers Technology Center 3700 are: after-final responses - (703)872-9303; other formal/official papers - (703)872-9302. The fax number for informal/draft papers - (703)305-9835.



**Clark F. Dexter
Primary Examiner
Art Unit 3724**

cfd
September 30, 2003